

### **REMARKS**

The Office Action mailed June 26, 2008, has been received and reviewed. Each of claims 1-55 stands rejected. Claims 1, 10, 17, 24, 31, and 36 have been amended herein. Accordingly, claims 1-55 remain pending. Care has been exercised to introduce no new subject matter. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

#### **Rejections based on 35 U.S.C. § 101**

Claims 17-23, 31-35, 51 and 54-55 were rejected under 35 U.S.C. 101 because the “media” in claims 17 and 31 may be wired or wireless, or signal, which is non-statutory subject matter. As more fully described below, it is respectfully submitted that claims 17-23, 31-35, 51 and 54-55, as currently amended, are directed to statutory subject matter.

Claims 17 and 31, as presently amended, recite a “computer-readable storage medium.” Applicants respectfully submit that, as written, a “computer-readable storage medium” constitutes a physical article that falls within the statutory class. Computer-readable storage medium does not include carrier waves. As such, it is respectfully submitted that claims 17-23, 31-35, 51 and 54-55 are directed at statutory subject matter. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 101 rejection of claims 17-23, 31-35, 51 and 54-55.

#### **Rejections based on 35 U.S.C. § 103**

##### **A. Applicable Authority**

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter

as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) with approval).” See also MPEP § 2142. “[R]jections on obviousness cannot be sustained with mere conclusory statements.” *Id.* Thus, in order to establish a prima facie case of obviousness the Office must provide “a clear articulation of the reason(s) why the claimed invention would have been obvious” based on factual findings made while conducting the *Graham* factual inquires. See MPEP § 2143. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. *Id.*

#### **B. Claims 1-55 are not Obvious over Huang and Pearson**

Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0097361 to Huang et al. (hereafter the “Huang reference”) in view of U.S. Publication No. 2003/0028610 to Pearson (hereafter the “Pearson reference”). As the differences between the claimed invention and the prior art references are significant, Applicants respectfully traverse the rejection, as hereinafter set forth.

Claim 1, as presently amended, recites a method of designating items as available to share in a computer system between a sharer that makes items available and a sharee that views the items that were made available. The method includes executing on the sharer's computer a query comprising a scope and criteria. The scope and the criteria are submitted by the user of the sharer's computer. The scope defines at least a portion of a physical storage location. The method also includes creating on the sharer's computer a list with a plurality of referenced items based on results of said query, wherein the referenced items include electronic files and electronic folders. The method also includes defining the contents of one or more virtual folders on the sharer's computer based on the list, the one or more virtual folders configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying and pasting. The method further includes making the contents of the one or more virtual folders available for sharing with the sharee, thereby making the results of said query available to the sharee. The method also includes sharing at least a portion of the one or more virtual folders with a the sharee such that the sharee is provided with access to the referenced items from the sharee's computer.

In contrast, the Pearson reference describes a peer-to-peer file sharing system and method. The Pearson reference describes a process by which a first host computer searches for a file on a second computer. The search query is suggested by the user of the searching computer which sends a request to the second computer. The second computer conducts a search of its available files and responds with a list of files that match the search criteria submitted by the first computer. *See* Pearson Reference [0030].

The Huang reference describes a system that provides a virtual desktop that can be accessed over the Internet from various client devices. *See* Huang reference Abstract. The

Huang reference describes assigning different levels of privacy to different folders. For example, one folder could be private; meaning only the owner could view the contents. A second folder could be public; meaning the contents could be viewed by others or even published to the public in general over the Internet. *See* Huang reference [0130].

There are several differences between claim 1 and the combination of references cited by the Office. For example, the combination of references does not teach “executing on the sharer’s compute a query comprising a scope and a criteria, wherein the scope and the criteria are submitted by the user of the sharer’s computer” as recited in claim 1. The Office correctly notes that the Huang reference does not describe this limitation. *See* Office Action dated June 26, 2008, p5. As described previously, the Pearson reference describes submitting search criteria on a sharee’s computer (referred to as the querying host 102 in the Pearson reference Fig. 4) that is in turn sent to the sharer’s computer (queried host 104 in Fig. 4). The sharer computer then conducts a search and returns a list of items that satisfy the search criteria. *See* Pearson reference [0030]. Thus, in Pearson “the scope and the criteria” are not submitted by the user of the sharer’s computer, but by the user of the sharee’s computer. This is the opposite of the feature of claim 1 described above. Further, the search in the Pearson reference is conducted over content that has already been designated for sharing. Accordingly, the combination of references does not describe “executing on the sharer’s compute a query comprising a scope and a criteria, wherein the scope and the criteria are submitted by the user of the sharer’s computer.”

A second difference between claim 1 and the combination of references cited by the Office is that the combination of references do not use search results to define the scope of files available for sharing. Claim 1 recites “defining the contents of one or more virtual folders on the sharer’s computer based on the list [produced as a result of the query]” and “making the

contents of the one or more virtual folders available for sharing with the sharee, thereby making the results of said query available to the sharee.” The Huang reference describes designating files for sharing by setting the privacy level on the file. *See* Huang Reference [0130]. However, the Pearson reference does not populate the content of a file with the result of a search query. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files for sharing, since they are already made available through a process that is not described in the Pearson reference.

Furthermore, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify the Huang and Pearson references to develop a method of making files available for sharing. The Huang reference describes designating content for sharing on a per folder basis; however, the selection of which content to place in the folder is not described. Neither reference uses the results of a query to make content available for sharing, let alone making the query results available for sharing by placing them in a virtual folder that may be accessed by others. A person having ordinary skill in the art would receive little or no guidance to help develop the method described in claim 1 from the combination of references. The only useful information gleaned from the combination of references is the very general proposition that files can be shared between computers over a network and that files and folders may be designated for sharing. The combination of references does not provide guidance that would lead a person having ordinary skill in the art to teachings of claim 1.

Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case because the differences between claim 1 and the cited references

are large. Further, the Office has not provided a rational underpinning to support the legal conclusion of obviousness in light of these significant differences. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claim 1.

Claims 2-9, 43-44, and 49 depend, either directly or indirectly, from allowable claim 1 and contain further limitations that are not described by the combination of references. For example, claims 2-4 describe adding and subtracting items from the list of available items that was originally generated as a result of the query. The combinations of references do not describe modifying the content of query results by adding to and/or subtracting items from the list. Claims 5-9 describe updating the contents of the virtual folder as new items that match the search criteria are added to the system or characteristics of existing items change to match, or cease to match, the search criteria. Accordingly, claims 2-9, 43-44, and 49 are allowable by virtue of their dependency from allowable claim 1 and further novel features described by the claims. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 2-9, 43-44, and 49.

Claim 10, as presently amended, recites a method for sharing items on a computer system. The method includes receiving permission to access a list on the sharer's computer with referenced items. The referenced items are based on the results of a query that includes a scope and a criteria provided by the sharer executed on the sharer's computer, and the list defines the contents of one or more virtual folders on the sharer's computer. The scope defines at least a portion of a physical storage location, and wherein referenced items include electronic files and electronic folders. The method also includes, in response to receiving the permission to access the list, accessing the list and the referenced items that have been determined by the sharer's computer to be shared in a sharing format, the sharing format being one of a static list and a

dynamic list. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Pearson reference and the Huang reference have been described previously with reference to claim 1. As with claim 1, there are several differences between claim 10 and the combination of references cited by the Office. For example, the combination of references does not teach “receiving permission to access a list on the sharer’s computer” where the list is “based on the results of a query provided by the sharer executed on the sharer’s computer” as recited in claim 10. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 10 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 11-16, 45-46 and 50 depend, either directly or indirectly, from allowable claim 10. Thus, claims 11-16, 45-46 and 50 are allowable at least by virtue of their dependency from allowable claim 10. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 11-16, 45-46 and 50.

Claim 17, as presently amended, recites one or more computer-readable storage media for enabling a computer-program segment to communicate with one or more other computer-program segments. The media includes a set of computer-usable instructions that cause a request to provide access to a set of items to be communicated to one or more other computer-program segments capable of executing said request, wherein the set of items include results of a query having a scope and criteria provided by the sharer executed on the sharer’s computer, and wherein the results are included one or more virtual folders on the sharer’s computer, wherein the scope defines at least a portion of a physical storage location, and wherein the set of items include electronic files and electronic folders. The one or more virtual folders

are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting, said referenced items are determined by the sharer's computer to be shared in a sharing format, the sharing format being one of a static list format and a dynamic list format.

The Pearson reference and Huang reference have been described previously with reference to claim 1. As with claims 1 and 10, there are several differences between claim 17 and the combination of references cited by the Office. For example, the combination of references does not teach a request for access to a set of items that "include results of a query provided by the sharer executed on the sharer's computer" as recited in claim 17. Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 17 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 18-23 and 51 depend, either directly or indirectly, from allowable claim 17. Thus, claims 18-23 and 51 are allowable at least by virtue of their dependency from allowable claim 17. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 18-23 and 51.

Claim 24, as presently amended, recites a method of communicating between a sharer of a list and a sharee. The method includes receiving, from the sharee, a call for accessing, on a computer of the sharer, items that are referenced on the list, wherein the list is based on results of a query with a scope and a criteria provided by the sharer executed on the



sharer's computer referenced in one or more virtual folders on the sharer's computer, and stored on the sharer's computer, and determined by the sharer's computer to be shared in a sharing format. The sharing format is one of a static list format and a dynamic list format and the scope defines at least a portion of a physical storage location, and wherein the sharer items include electronic files and electronic folders. The method also includes, responsive to authorization received from the sharer, providing the sharee access to the items in the determined sharing format. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Pearson reference and Huang reference have been described previously with reference to claim 1. There are several differences between claim 24 and the combination of references cited by the Office. For example, the combination of references does not teach "receiving from the sharee a call for accessing on a computer of the sharer items that are referenced on the list, wherein the list is based on the results of a query with a scope and a criteria provided by the sharer executed on the sharer's computer" as recited in claim 24. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 24 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 25-30, 47-48 and 52-53 depend, either directly or indirectly, from allowable claim 24. Thus, claims 25-30, 47-48 and 52-53 are allowable at least by virtue of their dependency from allowable claim 24. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11-16, 45-46 and 50.

Claim 31, as presently amended, recites one or more computer-readable storage media for enabling a sharer to share a set of items that are referenced on a list with a sharee. The

media includes a set of computer-usable instructions that allow the sharee to access the items directly through the sharer's computer. The items include electronic files and electronic folders. The set of items referenced on the list are based on results of a query with a scope and a criteria provided by the sharer executed on the sharer's computer. The scope defines at least a portion of a physical storage location. The list comprises an order of the items referenced on the list, the list is referenced in one or more virtual folders on the sharer's computer, the list is determined by the sharer's computer to be shared to the sharee in a sharing format, the sharing format being one of a static list format and a dynamic list format, and the one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Pearson reference and Huang reference have been described previously with reference to claim 1. There are several differences between claim 31 and the combination of references cited by the Office. For example, the combination of references does not teach "one or more computer-readable media for enabling a sharer to share a set of items that are referenced on a list with a sharee . . . wherein, the set of item referenced on the list are based on the results of a query with a scope and a criteria provided by the sharer executed on the sharer's computer" as recited in claim 31. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 31 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 32-35 and 54 depend, either directly or indirectly, from allowable claim 31. Thus, claims 32-35 and 54 are allowable at least by virtue of their dependency from allowable claim 31. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 32-35 and 54.

Claim 36, as presently amended, a method for sharing items in a computer system between a sharer and a sharee. The method includes executing on the sharer's computer a query comprising a scope and a criteria provided by the sharer, wherein the scope defines at least a portion of a physical storage location. The method also includes creating on the sharer's computer one or more virtual folders with a plurality of referenced items based on results of said query. The referenced items include electronic files and electronic folders. The method also includes determining a sharing format of the list to be shared to the sharee, wherein the sharing format is one of a static list and a dynamic list. The method also includes sharing the one or more virtual folders with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer in the determined sharing format. The method further includes one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Pearson reference and Huang reference have been described previously with reference to claim 1. There are several differences between claim 36 and the combination of references cited by the Office. For example, the combination of references does not teach "executing on the sharer's computer a query comprising a scope and a criteria provided by the sharer . . . creating on the sharer's computer one or more virtual folders with a plurality of referenced items based on the results of said query and . . . sharing the one or more virtual folders with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer " as recited in claim 36. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 36 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 37-42 and 55

depend, either directly or indirectly, from allowable claim 36. Thus, claims 37-42 and 55 are allowable at least by virtue of their dependency from allowable claim 36. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 37-42 and 55.

### **CONCLUSION**

For at least the reasons stated above, claims 1-55 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or johoward@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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